

### REMARKS

In response to the Office Action dated November 16, 2004, Applicants respectfully request reconsideration and withdrawal of the rejection of the claims.

Applicants also repeat their request to withdraw the finality of the Office Action. As pointed out in the Request filed December 9, 2004, claims 11 and 12 were not substantively amended in the response filed September 22, 2004. The rejection of these claims on the basis of a newly-cited reference therefore precludes the Office Action from being made final, according to MPEP § 706.07(a).

Subsequent to the filing of the Request, numerous calls were made to Examiner Jeffery and to his supervisor, in an effort to resolve this issue prior to filing a substantive response. However, neither of them could be reached, and the messages left on their voicemail have not been returned. For the reasons set forth in the Request, the Office Action dated November 16, 2005 should not have been made final, and withdrawal of the finality is respectfully requested.

To reduce the issues under consideration, claims 1-9 have been canceled, so that claims 10-12 are the only pending claims. Claim 10 has been allowed, so the sole remaining issue is the rejection of claims 11 and 12.

Claim 11 recites that the first heating member, for heating the smoking element in the container, is a light source, and claim 12 further recites that this light source is a halogen lamp. These two claims were rejected under 35 U.S.C. § 103, on the grounds that they were considered to be unpatentable over WO 00/56196 in view of the newly-cited Wertheimer patent (US 3,714,885). The Office Action relies upon WO 00/56196 for its teaching of the use of quartz tubes as heat sources in electric grills, and alleges that it is well-known to use lamps as quartz tube infrared

heat sources in grilles. The Office Action cites the Wertheimer patent for this proposition.

Even if it could be considered obvious to employ light sources for the quartz heating tubes of WO 00/56196, the result would not be the same as the subject matter recited in claim 11. The claim recites "a container adapted to contain a smoking element" and "a first heating element adapted to heat the smoking element in said container for producing smoke." The International Published Application is directed to a "smokeless" grill that is designed for indoor grilling. It teaches that the heating elements are employed to heat the foodstuff from above, so as avoid contact with dripping juices that could cause smoke. Thus, the International Published Application teaches away from using a container of smoking material, as well as using a light source to heat such a container.

In a similar manner, the Wertheimer patent is also directed to a cooking appliance that is designed to be used indoors. It only discloses the use of the quartz lamp tubes to heat the foodstuff itself. There is no teaching to use them to heat a smoking element in a container.

Accordingly, it is respectfully submitted that the teachings of International Published Application WO 00/56196 would not lead a person of ordinary skill in the art to utilize a light source as the mechanism for heating a container of smoking elements, whether considered by itself or in combination with the Wertheimer patent. As set forth in MPEP § 2143.03, all the claim limitations must be taught by the prior art reference (or references when combined) to establish a *prima facie* case of obviousness. Since neither of the International Published Application nor the Wertheimer patent disclose the heating of smoking elements in a container to

produce smoke, they cannot be interpreted to teach all of the claim limitations.

Reconsideration and withdrawal of the rejection of these claim 11 is therefore respectfully requested.

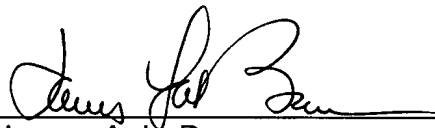
Claim 12 specifically recites that the light source is a halogen lamp. The rejection of this claim dismisses the patentability of this feature, on the grounds that "no criticality is seen in their use over quartz infrared heaters." To the contrary, however, halogen lamps offer significant advantages in the context of the present invention, when they are used to heat a smoking element. These lamps have the characteristic of very high energy density. For the same output, they are typically much smaller in size than corresponding quartz tubes and tungsten filament quartz lamps. Due to their small size, the heat capacity of halogen lamps is also relatively small. When a halogen lamp is switched off, it cools down rapidly and the residual heat is minimal. Since the halogen lamp is only required to heat the smoking element, these characteristics are ideal for instant smoking and de-smoking.

In contrast, both quartz tubes and tungsten filament quartz lamps are much bigger in size, lower in energy density, and higher in heat capacity. Hence, while they may be employed to heat the foodstuff, per se, they are not as suitable for use as a heat source to provide instant smoking and de-smoking, particularly on smaller tabletop grills. Hence, the subject matter of claim 12 offers appreciable advantages over the use of quartz lamps as heating elements.

For the foregoing reasons, it is respectfully submitted that claims 11 and 12 are patentable over the prior art of record, in addition to claim 10. A Notice of Allowance is submitted to be in order, and is respectfully solicited.

Respectfully submitted,  
BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: May 16, 2005

By:   
James A. LaBarre  
Registration No. 28,632

P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(703) 836-6620